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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/080,909 05/19/98 ISHIKAWA

G 1075.1013-CC

EXAMINER

PM82/0424

MOSKOWITZ, N

ART UNIT

PAPER NUMBER

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WASHINGTON DC 20001

3662

DATE MAILED:

04/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/080,909

Applicant(s)

ISHIKAWA ET AL.

Examiner

Nelson Moskowitz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 91-163 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 91-163 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 1998 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/233,830.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 6.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 91, 97, 99, 100, 102, 105, 107-116, 129, 131, 142, 143, 146, 147, 149, 150, 156, 157, 159, 162, and 163 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Dugan ('662). See, inter alia, figure 1 and column 1, lines 16-50.

3. Claims 91, 95, 97, 99, 101, 102, 105-116, 129-132, 135-139, 142-150, 156-159, 162, and 163 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Antos et al. See, inter alia, figure 14, and column 17.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 91-163 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dugan ('662) or Antos et al when taken with Prigent et al. The former references

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disclose fiber optic amplifier systems with the problem of chromatic dispersion and the cure of compensating for the dispersion.

Prigent et al teach the use of serial optical fibers having negative and positive dispersion values to compensate for optical dispersion inherent in fiber optical systems (col. 2, lines 1-30).

The difference between the claimed invention and this prior art lies in the combination of the serial corrective fibers of Prigent et al with the fiber optic amplifier systems of the primary references. However, as the prior art teaches both the need for dispersion correction in fiber optic amplifier systems and the cure of using serial corrective fibers, such combination would have been obvious to one skilled in this art.

The claim limitations as to the component housing, number of components and units, and WDM operation provide no novel or unexpected results and were merely obvious choices to one skilled in this art.

5. Nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 91-163 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-19 of U.S. Patent No. 5,602,666 and claims 1-12 of U.S. Patent No. 5,636,046. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of erbium as the lasing medium, WDM operation, and the number of components per housing provide no novel or unexpected results and were mere obvious choices to one skilled in this art.

6. The title and abstract of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the pending claims are directed.

7. The references cited by applicant (PTO-1449) have been considered and found fairly representative of the state of this art. The references cited by the examiner (PTO-892) teach the problem of chromatic dispersion and the use of corrective fibers.



NELSON MOSKOWITZ
PRIMARY EXAMINER